

REMARKS

SUMMARY

Reconsideration of the application is respectfully requested.

Claims 1-11 and 26-32 are now in the application. Claims 1-11 and 26-32 are subject to examination and claims 12-25 have been withdrawn from examination. Claims 1, 6-10, and 26-32 have been amended.

Applicants appreciatively acknowledge the Examiner's consideration and acceptance of the drawings filed on October 29, 2001. Moreover, the applicants acknowledge the Examiner's consideration of the Information Disclosure Citation submitted on February 26, 2002.

Claims 1-11 and 26-32 have been amended solely to provide clarification and/or for cosmetic reasons, such as adding punctuation and correcting a typographical errors. Support for the amendment can be found in Figures 1 and 3 and in the related specification. The changes are neither provided for overcoming the prior art nor do they narrow the scope of the claim for any reason related to the statutory requirements for a patent. Moreover, applicant believes that no new matter is introduced by the amendments.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

In "Claim Rejections – 35 USC § 102," item 4 on page 3 of the above-identified Office Action, claims 1-11 and 26-32 have been rejected as being fully anticipated by U.S. Published Application No. 2002/0082901 to *Dunning, et al.* (hereinafter "Dunning") under 35 U.S.C. § 102(e). Applicant respectfully traverses.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references, but have been amended solely for clarification and/or cosmetic reasons.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 1 calls for, *inter alia*, a method of **delivering digital media items to a plurality of user electronic devices** including:

delivering to the user electronic devices, via a computer network, the digital media items in a sequential order from a playlist, the playlist indicating a plurality of the digital media items to be delivered and the sequential order for their delivery to one or more of the user electronic devices;

receiving one or more **requests for at least one digital media item** from one or more of the user electronic devices; and

selectively adding an indication of the requested digital media item to the playlist on at least one of the user electronic devices **if the modified playlist would satisfy a set of restrictive criteria**.

Claim 26 contains similar language directed to one or more media servers for delivering digital media files to a plurality of client electronic devices, including:

a network connection for communicatively coupling one or more of the media servers with the **plurality of client electronic devices over the computer network**;

a playlist memory containing a playlist, wherein **the playlist indicates a sequential order to render a set of the digital media files**;

a media storage memory containing a library of the digital media files; and

a processor coupled with the network connection, the playlist memory, and the media storage memory, the processor operative to:
evaluate requests for digital media files from one or more of the client electronic devices **using a set of restrictive criteria**,

upon at least one of the requests satisfying the set of restrictive criteria, add an indication of the requested digital media file to the playlist; and

transmit digital media files according to the sequential order indicated by the playlist from the media storage memory to the plurality of client electronic devices over the computer network.

In contrast to these claims, Dunning discloses a relationship discovery engine to recommend items based on discovered relationships. Specifically, Dunning makes recommendations to a user based on a user profile generated using apparent user preferences in accordance with a binomial log likelihood ratio analysis technique. Dunning further indicates that this technique may be used to automatically generate track lists for a personalized radio station (see e.g., Dunning [0044] –[0049] on page 4).

Dunning appears to limit use of automatically generated track lists to a single user. Thus, although there may be several listeners connected to a jukebox, each listener is provided separate track lists “to be played by the user” (see e.g., Dunning [0121] on page 8) and generation of the separate track lists is based on determined preferences of that user “to populate ... with music tracks that are likely to appeal to a particular listener.” (Dunning [0049] on page 4) Moreover, there is no indication in Dunning that the same “media items” (claim 1) and/or “media files” (claim 26) are delivered to the “plurality of user electronic devices” as recited in claim 1 and/or “plurality of client electronic devices” as recited in claim 26 of the instant application. Rather, Dunning only indicates that the generated track list played on the personalized radio station may be sampled/heard by the primary user whose profile was used to generate the track list (see e.g., “a particular listener” in Dunning [0049] on page 4 and “the user” in Dunning [0121] on page 8).

In addition, Dunning does not teach or discuss the prophetic reconfiguration of a previously generated playlist in accordance with “a set of restrictive criteria” as recited in claims 1 and 26 of the instant application. Specifically, Dunning does not show projecting the effect of “selectively adding the requested media item to the playlist” with respect to “satisfying a set of restrictive criteria” as recited in claim 1 of the instant application. Thus, populating a programming block with various segments according to Dunning is limited to generating a new track list that is compliant with “heuristic rules for repetition limits and classes of songs” (Dunning [0049] on page 4) to automatically generate track lists, rather than modifying a previously available track list with a proposed/requested “media item” from

the user and evaluating whether the modified track list “would satisfy a set of restrictive criteria” as recited in claim 1 and claim 26 of the instant application.

Moreover, Dunning is limited to the automatic generation of track lists based on user profiles that are generated “without requiring users to complete questionnaires” (Dunning Abstract). In fact, in this respect the passive automatic track list generation of Dunning without active user input actually teaches away from the instant invention, where a playlist is constructed by “receiving a request for a media item from one or more of the users” and “selectively adding the requested media item to the play list” so long as the modified playlist would still satisfy “a set of restrictive criteria” as recited in claim 1 of the instant application. Ideally, in the personalized radio station operating in accordance with Dunning, the Dunning user does not need to make any requests because the track lists are automatically generated.

Clearly, Dunning does not show “delivering to the user electronic **devices**...digital media items” as recited in claim 1 of the instant application. Nor does Dunning anticipate “receiving one or more requests for at least one digital media item from ...one or more of the user electronic devices” and “selectively adding ... the requested digital media item...if the modified playlist would satisfy a set of restrictive criteria” as recited in claim 1 of the instant application.

Moreover, Dunning does not show “a playlist ... defines a set of media files in a sequential order” and “a processor... evaluates each request using set of restrictive criteria, if the playlist including the request would satisfy the set of restrictive criteria, adds the requested media file to the playlist” as recited in claim 26 of the instant application.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claim 1 and claim 26. Claim 1 is, therefore, believed to be patentable over the art. The dependent claims 2-11 and 27-32 are believed to be patentable as well for at least the same reasons as previously discussed, because they are ultimately dependent on either claim 1 or claim 26.

In addition to the reasons previously described for independent claims 1 and 26, applicant respectfully requests that the Examiner further consider each of the dependent claims individual on its own merits for additional grounds of patentability. Specifically, as Dunning indicates that the generated track list played on the personalized radio station may only be sampled/heard by the primary user whose profile was used to generate the track list (see e.g., “a particular listener” in Dunning [0049] on page 4 and “the user” in Dunning [0121] on page 8) dependent claims drawn towards group participation in the same playlist are also not anticipated by Dunning. For example, Dunning teaches against the limitation of satisfying “a set of group preferences” as recited in dependent claimd 2, 28 and 32, because if only the primary user is listening there is no need to satisfy a “group” preference.

Likewise, dependent claims drawn towards “requesting” are not anticipated by Dunning, because Dunning automatically suggests track lists based on user profiles that are generated “without requiring users to complete questionnaires” (Dunning Abstract) and not based on user requests as in the instant application. As such, Dunning does not anticipate insertng “a requested media item” at “a random position in the playlist” as recited in claim 3, because Dunning does not even modify its track lists based on user requests let alone randomly modify them. Accordingly, dependent claims calling for at least one “requested media item” as recited in claims 3, 4, 7, and 9, or for at least one “requested digital media file” as recited in claims 27, 30, and 31 or even for at least one “request” as recited in claims 6, 7, 9, 10, 27, 30, and 31 of the instant application are not anticipated by Dunning.

In the event the Examiner should still find any of the remaining claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out. In the alternative, the entry of the amendment is requested, as it is believed to place the application in better condition for appeal, without requiring extension of the field of search.

CONCLUSION

In view of the foregoing, reconsideration and allowance of claims 1-11 and 26-32 are solicited. As a result of the amendments made herein, Applicant submits that claims 1-11 and 26-32 are in condition for allowance. Accordingly, a Notice of Allowance is respectfully requested. If the Examiner has any questions concerning the present paper, the Examiner is kindly requested to contact the undersigned at (206) 407-1509. Moreover, if any fees are due in connection with filing this paper, the Commissioner is authorized to charge the Deposit Account of Schwabe, Williamson and Wyatt, P.C., No. 50-0393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

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